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EXAMINER
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* CYNTHIA ANN ADIANO, JONATHAN JAMES HURD,  
and MICHAEL TODD KNIGHT

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Appeal 2008-2144  
Application 09/733,737<sup>1</sup>  
Technology Center 2400

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Decided: December 23, 2008

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*Before:* JEAN R. HOMERE, JAY P. LUCAS, and THU A. DANG,  
*Administrative Patent Judges.*

LUCAS, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

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<sup>1</sup> Application filed December 8, 2000. The real party in interest is International Business Machines Corporation.

Appellants appeal from a final rejection of claims 46 to 52 and 58 to 75 under authority of 35 U.S.C. § 134. The Board of Patent Appeals and Interferences (BPAI) has jurisdiction under 35 U.S.C. § 6(b).

Appellants' invention relates to a method, system and computer program on machine readable media to securely distribute computer software as an attachment to e-mails in a manner that will discourage unauthorized further distribution of the software. In the words of the Appellants:

Secure software distribution is initiated by sending software media files to a recipient machine as an attachment to an electronic mail message. The software media files include an installation script that copies the program files and creates the icons necessary to run the application. The recipient opens the electronic mail message in his mail folder and clicks on an installation button to activate execution of the installation script. After successful completion of the installation the script is marked "used" and cannot be used again. Marking of the installation script as "used" also disables the forwarding mechanism of the electronic mail software to prevent the user from accessing a second copy of the software. When the recipient saves the electronic mail message, the "used" flag is set and the script can continue. The installation script stores the encrypted hard drive serial number into the system registry. When the application is launched, the hard drive serial number is read from the installation machine and compared to the value stored in the system registry. If the serial numbers match, the application is allowed to execute normally. If they do not match, the application terminates. This prevents the application from being used even if the entire hard drive image is copied to another machine.

(Spec., p. 24)

Claim 46 is exemplary:

46. A method comprising:

appending a software application program as an attachment to an e-mail message;

transmitting the e-mail message with the appended software application program to a receiving computer; and

permitting the software application program to run only if a determination is made that a disabling instructing has been incorporated into the e-mail message that prevents the e-mail message with the appended software application program from being forwarded.

The Examiner relies upon the following prior art relied in rejecting the claims on appeal :

Olkin	US 6,584,564 B2	Jun. 24, 2003
Leonard	US 6,721,784 B1	Apr. 13, 2004

### REJECTIONS

The Examiner rejects the claims in this appeal as follows:

R1: Claims 46 to 57 stand rejected under 35 U.S.C. § 112 ¶ 2 for being indefinite, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Ex. Ans., p. 5). In the Amendment of 10/26/05 Appellants canceled claims 53 to 57, so the rejection R1 will be applied to claims 46 to 52.

R2: Claims 46 to 75 stand rejected under 35 U.S.C. 103(a) for being obvious over Olkin and Leonard. (Ex. Ans., p. 5). In the Amendment of

10/26/05 Appellants canceled claims 53 to 57, so the rejection R2 will be applied to claims 46 to 52 and 58 to 75.

Claim 62 was neither listed as rejected in the Brief (Br., p.2) nor argued in the Brief (Br., p.6 and Br., p.11). It was clearly rejected by the Examiner. (Final Rej. mailed 8/26/05, ¶ 6). However, claim 61 from which it depends was listed and argued, and claim 63 which depends on claim 62 was listed and argued. We will therefore consider the omission of argument concerning claim 62 as an inadvertent error, and extend the arguments concerning the other claims as applying to claim 62.

#### Groups of Claims:

We will consider the claims in the order of the rejections R1 and R2 above.

Appellants contend that the claimed subject matter is merely broad, not unclear, and is not rendered obvious by Olkin in combination with Leonard, for reasons to be discussed more fully below. The Examiner contends that each of the claims is properly rejected.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this opinion. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived.

We reverse the rejection R1 under 35 U.S.C. § 112 ¶ 2, apply a new rejection R3 under 35 U.S.C. § 112 ¶ 1, and affirm the rejection R2 under 35 U.S.C. § 103.

### ISSUE

The first issue before us is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 112(2) for being unclear. The second issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The second issue turns on whether Olkin and Leonard teach the third step (permitting the software to run...) of the method for securely distributing software as an attachment to an e-mail message.

### FINDINGS OF FACTS

The record supports the following findings of facts (FF) by a preponderance of the evidence.

1. Appellants have invented a method for securely distributing software using e-mail that both stops the software from being downloaded from the e-mail more than once, and once installed, stops the software from running on any computer except the one on which it was installed. (Spec. 7, middle). Various events take place in accordance with this method: First, the software conveyed by an e-mail is installed on the computer in accordance with an installation script, in a disabled condition. Next the script is marked “used” so it cannot be used again. Forwarding is also disabled. Only when the e-mail is saved can the script

continue. Finally the application is enabled by installing the computer's hard drive serial number into the registry. The software is customized so it can only run if the serial number in the registry matches the ID number of the hard drive in the computer. (Process described in Spec., p. 7).

2. Olkin teaches a method of securely sending attachments to an e-mail by a Public Key Infrastructure (PKI) encryption technique that encodes the e-mail. (Col. 2, l. 10). Attachments are kept secure by the same encryption technique. (Col. 14, l. 36).
3. Leonard teaches another secure electronic mail system used for software distribution. (Col. 7, l. 25). Leonard specifically teaches that the software distribution is controlled so its carrier e-mail cannot be forwarded with the attached software beyond the intended recipient. (Fig. 5, #330; Fig. 12, box 20).

#### PRINCIPLES OF LAW

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner's position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of prima facie obviousness or by rebutting the prima facie case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

“It is common sense that familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1732 (2007).

“A court must ask whether the improvement is more than the predictable use of prior-art elements according to their established functions.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1731 (2007).

Under the written description requirement of 35 U.S.C. § 112, the disclosure of the application relied upon must reasonably convey to the artisan that, as of the filing date of the application, the inventor had possession of the later claimed subject matter. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). “One shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (emphasis in original).

A claim for computer instructions embodied in a signal only is not considered by this office to be statutory under 35 U.S.C. 101. This policy has been confirmed by the Court of Appeals for the Federal Circuit in *In re Nuijten*. “A transitory, propagating signal like Nuijten's is not a “process, machine, manufacture, or composition of matter.” Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter.” *In re Nuijten*, 500 F.3d 1346, 1359 (Fed. Cir. 2007).



## ANALYSIS

From our review of the administrative record, we find that the Examiner has presented a prima facie case for the rejections of Appellants' claims under 35 U.S.C. §§ 112(2) and 35 U.S.C. § 103(a). The prima facie case is presented on pages 4 to 11 of the Examiner's Answer<sup>2</sup>. In opposition, Appellants present a number of arguments.

*Arguments with respect to the rejection  
of claims 46 to 52  
under 35 U.S.C. § 112(¶2) [R1]*

The Examiner has rejected claims 46 to 52 for being unclear “as to who or who is permitting the software application from being run or forwarded. There does not appear to be a recitation as to who or who is making a determination or similarly processing the additional steps in claims 47 – 48.” (Ans., p. 5, top).

Appellants argue that a failure to specify who [or what] is permitting the software to run as claimed is a matter of breadth of the claim, not its indefiniteness, citing the MPEP § 2173.04. (Br., p. 7, middle). This is accurate, and we will not sustain the rejection on the grounds of being unclear.

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<sup>2</sup> We observe that a rejection under 35 U.S.C. § 101 has not been applied to claims 70 to 75 for being non-statutory, although they encompass a computer readable medium comprising a modulated signal (see Specification, page 10). In view of *In re Nuijten*, 500 F.3d 1346, 1359 (Fed. Cir. 2007) Appellants are advised in any future prosecution of this application to make suitable amendments to avoid non-statutory claims.

However, the Examiner explains further in the Answer, page 12 (middle) to page 15 (bottom) that he really meant that the claims' requirement that the application program run only if certain conditions were met was not supported by the Specification. This is not a question of clarity under 35 U.S.C. § 112 (2) but rather a question of written description under 35 U.S.C. § 112 (1). Thus we will not affirm the rejection [R1] under 35 U.S.C. § 112 (2), but will impose a new rejection, as indicated directly below.

[R3] REJECTION OF CLAIMS 46 TO 52 AND 64 TO 75 UNDER  
37 C.F.R. § 41.50(B)

We make the following new ground of rejection using our authority under 37 C.F.R. § 41.50(b).

Rejection:

Claims 46 to 52 and 64 to 75 are rejected under 35 U.S.C. § 112 ¶ 1 as failing to comply with the written description requirement. The claims contain subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. More particularly, the claim requires that the software program is permitted to run only if a determination is made that a disabling instruction is incorporated into the e-mail preventing the e-mail from being forwarded. We considered the methodology of the Specification explained in FF#1 above, and agree with the Examiner's analysis of lack of written description. The permission for the software application to run is strictly a matter of matching the serial number of the hard drive to that same number in the registry, as placed during installation. The permission for forwarding

the e-mail message is related to the installation of the (disabled) software onto the computer and the saving of the e-mail. (FF#1). Thus the claim is not supported by the Specification.

*Arguments with respect to the rejection  
of claims 46 to 52 and 58 to 75  
under 35 U.S.C. § 103*

Appellants contend that Examiner erred in rejecting claims 46 to 52 and 58 to 75 under 35 U.S.C. 103(a) for being obvious over Olkin and Leonard. Reviewing the findings of facts cited above, we find the prima facie case was presented by the Examiner, as noted above. Appellants argue that

Leonard fails to ever describe the specifically claimed step of permitting a software application program (which is appended to an e-mail as an attachment) “to run only if a determination is made that a disabling instruction has been incorporated into the e-mail message that prevents the e-mail message with the appended software application program from being forwarded.”

(Br., p. 8, middle)

Further, Appellants contend “there is no teaching or suggestion by the combination of cited references of making execution of the appended software contingent upon the carrier e-mail being unable to be forwarded by the recipient.” (Br., p. 8, bottom).

Leonard teaches placing software controls in the recipient’s computer which limit the ability to forward received e-mails, including those containing attachments. (Col. 19, l. 34). Leonard specifically teaches that the e-mails can contain attachments for the distribution of software to run on

a computer. (Col. 8, l. 25). Thus a user can permit a software application program to be loaded (and subsequently run) only if the e-mail contains an instruction preventing the e-mail from being forwarded. This is done by the user sending the e-mail by simply clicking the Do Not Forward restraint.

With regard to claim 58, since the software was an attachment of the e-mail, an ordinarily skilled artisan would have found it as being an obvious modification of the Leonard system to inhibit the installation of the attached software until the carrier e-mail is saved on the receiving computer. Indeed until the e-mail is safely received (saved) installation of the attachment is not even possible. With regard to claim 59, we find the term “pre-specified” applied to the server is sufficiently generic to encompass the mail servers of Olkin or Leonard. The issue of claim 60 is discussed above (forwarding). Claim 61 claims a modification of the security feature of Olkin discussed by the Examiner in his rejection. (Ans., p. 9, top). We do not find error in the Examiner’s application of the art against claim 61. Finally, with regard to claim 63, we find that Olkin teaches the ability to limit the number of times the software may be stored to a particular number (col. 9, l. 32) includes the particular number “one”.

We thus find no error in the Examiner’s rejection of the noted claims over the teachings in Olkin and Leonard.

### CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner erred in rejecting claims 46 to 52 under 35 U.S.C. § 112 ¶ 2 [R1]. We also conclude that the Examiner did not err in rejecting claims 46 to 52 and 58 to 75 under 35 U.S.C. § 103 [R2].

### DECISION

R1: We reverse the rejection of claims 46 to 52 under 35 U.S.C. § 112 ¶ 2 for being indefinite, for failing to particularly point out and distinctly claim the invention.

R2: We affirm the rejection of claims 46 to 52 and 58 to 75 under 35 U.S.C. 103(a) for being obvious over Olkin and Leonard.

[R3]: We have entered a new grounds of rejection under 37 C.F.R. § 41.50(b) for claims 46 to 52 and 64 to 75 for failing to comply with the written description requirement of 35 U.S.C. 112, ¶ 1.

With respect to the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides that “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the Examiner’s rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

Appeal 2008-2144  
Application 09/733,737

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

37 C.F.R. § 41.50(b)

pgc

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